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10/056,050	01/28/2002	Shmuel Cabilly	IVGN 309.3	1920
52059 7590 07/27/2007 INVITROGEN CORPORATION C/O INTELLEVATE P.O. BOX 52050 MINNEAPOLIS, MN 55402			EXAMINER BARTON, JEFFREY THOMAS	
			ART UNIT 1753	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/056,050

Applicant(s)

CABILLY ET AL.

Examiner

Jeffrey T. Barton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 77 is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-14, 19-21, 50, 53-56, 58-60, 62-65, 67-69, 71, 75, 79-82, 85-91 and 93-102 is/are rejected.
- 7) ☒ Claim(s) 18 and 73 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1-9,12-14,18-21,50,53-56,58-60,62-65,67-69,71,73,75,77,79-82,85-91 and 93-102.

DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 02 May 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,379,516 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Status of Objections and Rejections Pending Since the
Office Action of 03 January 2007***

2. The rejections of claims 18, 73, and 77 under the judicially created doctrine of obviousness-type double patenting are obviated by the acceptance of Applicant's terminal disclaimer over U.S. Patent No. 6,379,516.
3. All claim objections have been obviated by Applicant's amendment, and are therefore withdrawn.
4. The rejections of claims 56 and 79 under 35 U.S.C. §112, second paragraph are withdrawn due to Applicant's amendment.
5. The rejection of claim 77 under 35 U.S.C. §103(a) as unpatentable over Pace in view of Monthony et al is withdrawn due to Applicant's amendment.
6. All other rejections are maintained.

Claim Rejections - 35 USC § 112

7. Claims 85 and 86 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These claims require the cathode and anode, respectively, to be in the third region, although claim 1 requires these electrodes to be positioned in either the first or second region. Claim 85 is treated as though it requires the cathode to be within the first region, and Claim 86 is treated as though it requires the anode to be within the first region. Appropriate correction is required.

Double Patenting

8. Applicant is advised that should claim 99 be found allowable, claim 102 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-4, 62, 71, 85-87, 91, and 94-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tocci in view of Elson et al.

Regarding claim 1, Tocci discloses a disposable electrophoresis cassette (Figures 1-6) comprising an enclosed chamber having top (5), bottom (4), side (2) and end (3) walls as claimed; wherein the bottom wall is contiguous and the chamber

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comprises three regions as claimed (e.g. narrow central section as the first region with reservoir regions on either side); wherein the chamber comprises an electrophoresis area (e.g. central section); a gel matrix within the chamber comprising an electrolyte (Column 3, lines 8-18); and an anode and cathode disposed in respective sealed regions 6 and 7. (Foil electrodes 8, in contact via semi-solid buffer; Column 2, lines 9-30)

Regarding claim 2, Tocci discloses all regions being sealed before and during electrophoresis. (e.g. Figures 4 and 5 - electrode 8 folds out, then is held in position for electrophoresis by the lid after sealing; also support medium 12 disposed on lid provides buffer at the time of use; Column 3, lines 8-24; Column 4, line 55 - Column 5, line 4)

Regarding claims 3, 4, and 62, Tocci discloses metal foil electrodes. (Column 6, lines 10-11) Any metal can be electrochemically ionized under certain conditions, including electrophoresis, given a high enough voltage and choice of/lack of solvent, etc.

Regarding claim 71, Tocci discloses a method of using his cassette comprising loading samples and applying an electrical field. (Column 3, lines 54-67)

Regarding claims 85 and 86, either reservoir of Tocci (6 or 7) corresponds to the instant first or second region, and either could clearly contain the anode or cathode.

Regarding claims 87 and 91, the electrodes 8 are embedded in the reservoir gel, which transmits the electric field, therefore reading on the claimed "electrophoresis gel matrix". (Figures 3-5)

Regarding claims 94-100 and 102, the top wall of Tocci is sealed to the side walls and end walls during operation, thus sealing the first and second regions (Figures 3-5; Column 4, lines 55-57; Column 5, lines 1-4 describe how electrode tabs are folded out such that the lid will be placed on the chamber while allowing current to be applied to the cassette), and the bottom wall has several planar sections, which can each be described as "flat". (Figure 3)

Tocci does not explicitly disclose a unit comprising apertures for sample loading or wells disposed below the apertures. Specific to claim 101, Tocci also does not disclose the instant comb.

Elson et al disclose a gel cassette (Figure 1) wherein samples are applied into wells formed in the gel through apertures (21) provided in the cover of the gel cassette. (Abstract; Column 2, lines 25-36) The templates taught by Elson et al are positioned in a carrier, 24, and the assembly thus inserted into the cassette reads on the comb of claim 101. (Figure 1; Column 3, lines 5-14)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the unit of Tocci by providing a row of apertures in the cover for sample loading, as taught by Elson et al, because Elson et al teaches the advantages of this design, in that it allows for a range of sample volumes and allows samples to be applied without opening the instrument. (Column 1, lines 36-38; Column 4, lines 5-14) In using the apertures taught by Elson et al, it would of course have been obvious to use the template carrier (24) and templates (20) taught by Elson et al, which

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are positioned in the gel matrix via the apertures, upon gelation. (Column 2, lines 27-36; Column 3, lines 5-14)

13. Claims 5, 6, 63, 64, 75, and 88 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tocci and Elson et al as applied to claims 1-4, 62, 71, 85-87, 91, and 94-102 above, and further in view of Pace.

Tocci and Elson et al disclose an electrophoresis unit as described above in addressing claims 1-4, 62, 71, 85-87, 91, and 94-102.

Neither Tocci nor Elson et al explicitly require any specific metal for the electrodes, although Tocci suggests nichrome or platinum. (Column 3, lines 46-47)

Pace discloses an electrophoretic device with copper or silver electrodes. (Column 7, lines 36-39)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the device of Tocci by using copper electrodes, as taught by Pace, because it would reduce the cost of manufacture compared to the more standard platinum or gold electrodes for a disposable electrophoresis unit.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the device of Tocci by using silver electrodes, as taught by Pace, because it would reduce the cost of manufacture compared to the more standard platinum or gold electrodes for a disposable electrophoresis unit, while still being less reactive than most metal alternatives. (e.g. Cu)

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Furthermore, given that Tocci does not specifically require any metal, but only suggests nichrome or platinum, it would have been a matter of choice to a skilled artisan to select an appropriate electrode material from those known in the art of electrophoresis, such as copper or silver.

Specific to claims 75 and 88, if copper or silver is used for the anode, metal ions will preferentially form rather than water hydrolysis products and will be present in the gel matrix, meeting the limitations of these claims. This is a property of these metals that is recognized by applicant. (Specification; Page 10, lines 7-13)

14. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tocci and Elson et al as applied to claims 1-4, 62, 71, 85-87, 91, and 94-102 above, and further in view of Eibl et al.

Tocci and Elson et al disclose an electrophoresis unit as described above in addressing claims 1-4, 62, 71, 85-87, 91, and 94-102.

Neither Tocci nor Elson et al explicitly require any specific metal for the electrodes, although Tocci suggests nichrome or platinum. (Column 3, lines 46-47)

Eibl et al disclose an electrophoretic device with aluminum electrodes. (Column 3, lines 30-37)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Tocci by using aluminum electrodes, as taught by Eibl et al, because it would reduce the cost of manufacture compared to the more standard platinum or gold electrodes for a disposable electrophoresis unit.

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Furthermore, given that Tocci does not specifically require any metal, but only suggests nichrome or platinum, it would have been a matter of choice to a skilled artisan to select an appropriate electrode material from those known in the art of electrophoresis, such as aluminum.

Further addressing claims 7 and 9, although Eibl does not specifically address the oxygen-absorbing abilities of aluminum, this is an innate property of the metal and would allow the gel to remain substantially oxygen-free, even if water electrolysis did occur.

15. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tocci and Elson et al as applied to claims 1-4, 62, 71, 85-87, 91, and 94-102 above, and further in view of Flesher et al.

Tocci and Elson et al disclose an electrophoresis unit as described above in addressing claims 1-4, 62, 71, 85-87, 91, and 94-102.

Neither Tocci nor Elson et al explicitly require any specific metal for the electrodes.

Flesher et al disclose an electrophoretic device with palladium electrodes.
(Column 5, lines 29-34)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Tocci by using palladium electrodes, as taught by Flesher et al, because they are highly resistive to corrosion.

Furthermore, given that Tocci did not specifically require any metal, it would be a matter of choice to a skilled artisan to select an appropriate electrode material from those known in the art of electrophoresis, such as palladium.

Further addressing claims 19 and 21, although Flesher et al do not specifically address the hydrogen-absorbing abilities of palladium, this is an innate property of the metal and would allow the gel to remain substantially hydrogen-free, even if water electrolysis did occur.

16. Claims 12-14 and 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tocci and Elson et al as applied to claims 1-4, 62, 71, 85-87, 91, and 94-102 above, and further in view of Day.

Tocci and Elson et al disclose a combined electrophoresis unit as described above in addressing claims 1-4, 62, 71, 85-87, 91, and 94-102 above.

Specific to claim 13, Elson et al also disclose these sites being disposed in a row. (Figure 1)

Neither Tocci nor Elson et al explicitly disclose spacing the apertures to conform with intervals between tips on a loader (Claims 12, 24, and 41), or apertures arranged in a stagger format. (Claims 14, 26, and 43)

Day discloses an electrophoresis gel with sample wells spaced to match the spacing of standard multichannel pipettes. (Page 5, line 24 - Page 6, line 23) He also discloses staggered arrangement of wells. (e.g. Figure 4)

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the combination of Tocci and Elson et al by spacing the sample application slots taught by Elson to match the 9 mm spacing of multichannel pipettes, as taught by Day, because Day teaches the economy of time and labor in sample loading that such an arrangement allows. (Page 5, line 30 - Page 6, line 4)

It would also have been obvious to one having ordinary skill in that art to provide multiple, staggered rows of sample wells, as taught by Day, because Day teaches that this arrangement allows a much more efficient use of the gel space in that many more samples can be run in a single gel. (Page 5, line 10 - Page 6, line 4)

17. Claims 53, 56, 65, 79, 80, 81, 82, 89, 90, and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tocci and Elson et al as applied to claims 1-4, 62, 71, 85-87, 91, and 94-102 above, and further in view of Monthony et al.

Tocci and Elson et al disclose a combined electrophoresis unit as described above in addressing claims 1-4, 62, 71, 85-87, 91, and 94-102 above.

Neither Tocci nor Elson et al explicitly disclose any particular buffer solution.

Monthony et al disclose electrophoresis methods, one of which involves using a Tris/Glycine buffer for separations at pH 8.9. (Table in Column 4, Example 1)

It would also have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Tocci by using the buffer system disclosed by Monthony et al, because Tocci left this choice up to the skilled artisan

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using his invention, and one having ordinary skill would be able to select an appropriate buffer for a given separation from those known in the prior art. In addition, Monthony teach that electrophoresis of human serum on a gel using this buffer resulted in "sharply separated bands" (Column 6, lines 33-35), which would clearly be desirable to a skilled artisan.

Applicant did not invent Tris/Glycine and the other buffers claimed here. A property not seen in the prior art of record is claimed here, but the discovery of a new property of a known material does not necessarily patentably distinguish the claim. See *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999) and *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). There are no structural distinctions between the claimed invention and the prior art as combined above.

Specific to claims 79, 81, 89, and 93, since Applicant teaches that the Tris/Glycine buffer is a composition that meets the limitations of these claims (Note claim 80, for example), this combination meets all positively recited limitations of these claims.

18. Claims 54 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tocci, Elson et al, and Monthony et al as applied to claims 53, 56, 65, 79, 80, 81, 82, 89, 90, 92, and 93 above, and further in view of Pace.

Tocci, Elson et al, and Monthony et al disclose a cassette as described above in addressing claims 53, 56, 65, 79-82, 89, 90, 92, and 93.

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None among Tocci, Elson et al, or Monthony et al explicitly require any specific metal for the electrodes, although Tocci suggests nichrome or platinum. (Column 3, lines 46-47)

Pace discloses an electrophoretic device with copper or silver electrodes. (Column 7, lines 36-39)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the device of Tocci by using copper electrodes, as taught by Pace, because it would reduce the cost of manufacture compared to the more standard platinum or gold electrodes for a disposable electrophoresis unit.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the device of Tocci by using silver electrodes, as taught by Pace, because it would reduce the cost of manufacture compared to the more standard platinum or gold electrodes for a disposable electrophoresis unit, while still being less reactive than most metal alternatives. (e.g. Cu)

Furthermore, given that Tocci does not specifically require any metal, but only suggests nichrome or platinum, it would have been a matter of choice to a skilled artisan to select an appropriate electrode material from those known in the art of electrophoresis, such as copper or silver.

Specific to claims 75 and 88, if copper or silver is used for the anode, metal ions will preferentially form rather than water hydrolysis products and will be present in the gel matrix, meeting the limitations of these claims. This is a property of these metals that is recognized by applicant. (Specification; Page 10, lines 7-13)

19. Claim 50 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tocci, Elson et al, and Monthony et al as applied to claims 53, 56, 65, 79, 80, 81, 82, 89, 90, 92, and 93 above, and further in view of Eibl et al.

Tocci, Elson et al, and Monthony et al disclose a cassette as described above in addressing claims 53, 56, 65, 79-82, 89, 90, 92, and 93.

None among Tocci, Elson et al, or Monthony et al explicitly require any specific metal for the electrodes, although Tocci suggests nichrome or platinum. (Column 3, lines 46-47)

Eibl et al disclose an electrophoretic device with aluminum electrodes. (Column 3, lines 30-37)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Tocci by using aluminum electrodes, as taught by Eibl et al, because it would reduce the cost of manufacture compared to the more standard platinum or gold electrodes for a disposable electrophoresis unit.

Furthermore, given that Tocci does not specifically require any metal, but only suggests nichrome or platinum, it would have been a matter of choice to a skilled artisan to select an appropriate electrode material from those known in the art of electrophoresis, such as aluminum.

Further addressing claims 7 and 9, although Eibl does not specifically address the oxygen-absorbing abilities of aluminum, this is an innate property of the metal and

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would allow the gel to remain substantially oxygen-free, even if water electrolysis did occur.

20. Claims 58-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tocci, Elson et al, and Monthony as applied to claims 53, 56, 65, 79, 80, 81, 82, 89, 90, 92, and 93 above, and further in view of Day et al.

Tocci, Elson et al, and Monthony et al disclose a cassette as described above in addressing claims 53, 56, 65, 79-82, 89, 90, 92, and 93.

Specific to claim 13, Elson et al also disclose these sites being disposed in a row. (Figure 1)

None among Tocci, Elson et al, or Monthony et al explicitly disclose spacing the apertures to conform with intervals between tips on a loader (Claims 12, 24, and 41), or apertures arranged in a stagger format. (Claims 14, 26, and 43)

Day discloses an electrophoresis gel with sample wells spaced to match the spacing of standard multichannel pipettes. (Page 5, line 24 - Page 6, line 23) He also discloses staggered arrangement of wells. (e.g. Figure 4)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to further modify the combination of Tocci and Elson et al by spacing the sample application slots taught by Elson to match the 9 mm spacing of multichannel pipettes, as taught by Day, because Day teaches the economy of time and labor in sample loading that such an arrangement allows. (Page 5, line 30 - Page 6, line 4)

It would also have been obvious to one having ordinary skill in that art to provide multiple, staggered rows of sample wells, as taught by Day, because Day teaches that this arrangement allows a much more efficient use of the gel space in that many more samples can be run in a single gel. (Page 5, line 10 - Page 6, line 4)

Allowable Subject Matter

21. Claim 77 is allowed.

22. Claims 18 and 73 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

23. The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 77, none of the prior art of record teaches or fairly suggests a method comprising both the instant degrading and inhibiting steps within a gel having wells as claimed.

Response to Arguments

24. Applicant's arguments filed 02 May 2007 have been fully considered but they are not persuasive.

Applicant argues against the combination of Tocci and Elson et al, arguing that there would be no advantage to using the top wall of Elson et al with Tocci. Despite the lengthy description of the respective references provided by Applicant, the Examiner must maintain that the convenience of the sample loading ports taught by Elson would have been abundantly clear to anyone of skill in the art of gel electrophoresis, in that their presence allows accurate sample application without the need to disassemble the device for loading. The motivation for modification is clear and valid. There is no reason to believe that a series of small holes will destroy the function of the lid "to prevent substantial evaporation" from the cassette, as the volume of the cassette is still substantially covered with the lid. Applicant's argument that there is no expectation of success due to the lack of examples in Tocci is not persuasive. Based on the teachings of the reference, the cassette of Tocci functions as disclosed, and there is no reason to believe that this function would be impeded by the modification taught by Elson et al. In addition, the fact that Tocci discloses loading samples on the electrophoresis medium cannot reasonably be construed as teaching away from the provision of wells. Teaching one way of performing a function does not constitute teaching away from every other way of performing the function. Wells are advantageous in providing accurate and defined sample application, and are entirely conventional in the art due to this advantage. Regarding the sealing limitation, the provision of loading apertures and wells in the electrophoresis region of Tocci clearly leads to the third region not being "sealed", while the first and second regions remain sealed.

Regarding the rejection further in view of Monthony et al, Applicant takes issue with an inherency argument in a 103 rejection. The Examiner replies that the obvious combination provides a buffer that is disclosed by Applicant as having the claimed property. The function will therefore be present in the combined device. The rejection is entirely proper since the motivation for the rejection has nothing whatsoever to do with either inherency or the Applicant's disclosure. The obvious combination will have the claimed properties. Note MPEP §2112. All limitations of the claims are met by the prior art.

All other arguments against rejections based on Tocci rely upon the arguments that are not persuasive for the reasons indicated above.

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Jeffrey T. Barton whose telephone number is (571) 272-1307. The examiner can normally be reached on M-F 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JTB
19 July 2007


ALEX NOGUERA
PRIMARY EXAMINER
AU 1753
July 23, 2007